

REMARKS**I. Claim Status:**

Claims 1-23 and 26 are pending and are subject to a restriction and/or election requirement. Pending claims, 1-23 and 26, have been deemed to be directed to three patentably distinct groups of inventions. Pursuant to 35 U.S.C. § 121, Applicants provisionally elect Group II. Currently pending claims 4-15 read on Group II. Claims 1-3, 16-23 and 26 are canceled without prejudice. Claims 12-15 have been amended to properly recite a biochip as the subject matter rather than microelectrodes as the claims depend ultimately from claim 4, which is drawn to a biochip. No new subject matter has been added by the amendments. Entry and consideration are respectfully requested.

II. Restriction Requirement:

Claims 1-3 have been deemed drawn to an apparatus for electroporation. Claims 4-15 have been deemed drawn to a biochip. And claims 16-23 and 26 have been deemed drawn to a method of electroporation. The groups are asserted to not relate to a single general inventive concept, and to lack the same or corresponding special technical feature.

The examiner has characterized the technical feature of Group I (claims 1-3) as being a biochip having an array of microelectrodes. The technical features of Group II (claims 4-15) and Group III (claims 16-23 and 26) are not specified as the technical feature of Group I is described as not making a contribution over the prior art, specifically Lewis (U.S. 6,352,535). Because the technical feature of Group I is allegedly shown in the prior art, it cannot be a *special technical feature* shared in common by the three invention groups. Applicants respectfully traverse the

restriction requirement.

There is a fundamental error with respect to the characterization of the general inventive concept of Group I. The characterization is too broad. The correct general inventive concept is a biochip having an array of *individually driven or individually controllable* microelectrodes. Lewis does disclose a biochip with an array of microelectrodes. Lewis *does not* disclose an array of microelectrodes that are individually driven. Closer scrutiny of Lewis supports this conclusion.

Lewis specifically states, "[t]he concept can also be extended to the electroporation of individual cells and assemblies of cells in which the state of the prior art is a macroscopic device with macroscopic electrodes placed in a large bath with a solution of cells Instead of this a microelectrode for local electroporation of individual cells is used, or alternatively, an array of microelectrodes could be applied for poration of assemblies of cells." [2:18-26]. This relationship between number of microelectrodes and number of cells acted upon is reiterated at [3:32-35].

The precise language of Lewis clearly describes the poration of a *single* cell with a *single* microelectrode, or the poration of an *aggregate* of cells with *multiple* microelectrodes. Lewis neither discloses nor suggests the individual control of a single microelectrode in an array of microelectrodes to conduct poration of an individual cell. It is the individual control of a microelectrode in an array of microelectrodes in Applicants' claimed invention that forms the single general inventive concept that is, indeed, a *special inventive concept* in accordance with the requirements to establish unity of invention under the PCT Rules.

With the single general inventive concept properly defined, the sharing of this concept by the three designated groups of claims becomes obvious. Claim 1 from Group I recites an apparatus comprising ". . . a biochip containing an array of

microelectrodes and a control system that permits transfer of a signal *to a pre-selected microelectrode of biochip.*" (Emphasis added). Claim 4 from Group II recites a "biochip comprising an array of *individually driven microelectrodes*" (Emphasis added). Lastly, claim 16 from Group III, by virtue of its incorporation of the elements of claim 1, shares the single general inventive concept of Groups I and II. Accordingly, the general inventive concept is shared by Groups I-III.

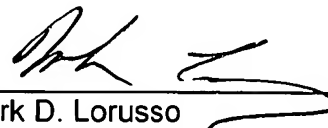
For these reasons, the restriction requirement is improper, and more specifically improper as it is premised on an incorrect characterization of the general inventive concept. Applicants respectfully request the restriction requirement be reconsidered and removed.

III. Conclusion:

For all the foregoing reasons, the claims are considered to share a single general inventive concept and to define patentably over the prior art. Reconsideration is requested and favorable action is solicited.

Respectfully Submitted,

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